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TABLE OF CITATIONS.

Cases:

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Great Atlantic & Pacific Tea Co. v. Supermarket Equipment
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Southern States Equipment Corp. v. USCO Power Equipment
Corp., 209 F. 2d 111 (5th Cir., 1953) .....

United States v. Adams, 383 U. S. 39 (1966) .....

Wheaton v. Peters, 8 Pet. 591 (1834) .....

Statutes:

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Rules:

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Publications:

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Modern Art, New York", Museum of Modern Art in 19

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

FOREWORD

This is a commonplace action for patent infringement
n ordinary invalid design patent, in which the District
rt concluded that the subject matter of the patent in
was not obvious, and the Circuit Court, in reversing,
nimously concluded that it was obvious. This case meets
e of the criteria required by this Court as reasons for
ting review on certiorari as set forth in its Rule 19.

Petitioner, Hadco, has phrased its "QUESTIONS
ESENTED FOR REVIEW" in an attempt to conform
ese criteria. In actuality, however, the decision of the
uit Court for which review is sought, is not in conflict
any decision of any other court of appeals on the same
t, nor with the statutes, nor with the applicable deci-
s of this Court.

Chief Justice Taft's admonition set forth in *Keller v.*
as-Campbell Co., Inc., 264 U. S. 314, 319 (1924) applies
special force to the subject case:

"Such an ordinary patent case, with the usual issues
f invention, breadth of claims, and non-infringement,
his Court will not bring here by certiorari unless it be
ecessary to reconcile decisions of circuit courts of ap-
eal on the same patent."

Respondent, Kidde, accepts Hadco's statement of the
s, opinions, and judgments below, and jurisdictional
ds.

With regard to the statement of the case Hadco has
ated or twisted the record in many aspects. By way
ample, Hadco asserts "undisputed testimony" of
ersality of application" for the fixture of the patent

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in suit. This is based on the direct examination tes
of the patentee, Daum. On subsequent cross-exami
Daum conceded that *all* lighting fixtures are of u
application (Record 547a to 548a):*

> "A. *Of course, all fixtures are of universal*
> *cation if you want to put it on an application. It*
> *to the individual.* (Emphasis added.)

Indeed, he characterized as ridiculous any as
that either his fixture was unique in being of univer
sign, or that the prior art fixtures were not of u
design:

> "Q. . . . You didn't understand that as
> that your Tudor was of universal design, could b
> anywhere and these others could not and you
> determine it?
>
> "A. I didn't mean that way. I really didn
>
> "Q. I see.
>
> "A. *Because that would be ridiculous to*
> *statement like that.*" (Emphasis added.)

Parenthetically, Hadco's statement infers that
small company, which has been manhandled by
Actually, as reflected by the record, Hadco is a wholly
subsidiary of Esquire, Inc., a corporation on the Ne
Stock Exchange.

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* Refers to the Joint Appendix Filed in Appeal to th
States Court of Appeals for the Third Circuit.

ARGUMENT

Question in This Case Is Worthy of Review.

The Design of the Patent in Suit Is a Trivial Obvious Departure From the Prior Art.

The patent in suit, Daum's Design Patent 199,143, ents a trivial obvious departure from the prior art. , the design constitutes a combination of elements, of which is present in the prior art. Daum testified what made the fixture of his patent interesting to the was its contour or silhouette, i.e. in his deposition DX-521a, he stated:

"Primarily, silhouette. That is what makes it interesting to the eye." (Emphasis added.)

A comparison of Kidde's prior art Item No. 5, No. 469, rimposed over the drawing of the patent application h issued as the patent in suit is set forth in the accom- ing Appendix. As the Circuit Court held, and as is diately evident, the prior art fixture is "quite similar e Hadco fixture in overall silhouette and contour").[1]

The minor details not present in this reference are, as Circuit Court found, clearly shown in the prior art.[2]

. [(A14) refers to page 14 of the Appendix to Petition for a of Certiorari to the United States Court of Appeals for the Third it.] While Hadco has dwelled on some of Kidde's secondary art references, even to the point of illustrating them in its Peti- it has studiously avoided in both its Petition and Appendix the superimposed comparison set forth in the accompanying Appen- hich was relied upon by the Circuit Court, A14. At the bottom e 9 of the Petition, Hadco refers to a "Christmas tree" effect. estly, if the silhouettes of the prior art fixture and of the ed fixture are similar, they must both resemble a "Christmas f either of them does so.

. The Circuit Court noted that while No. 469 is directed to a ded cage and a round roof, yet (A14):

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Viewed in a position most favorable to Hadco, these d
are, as the Circuit Court found "clearly recogniz
simple modifications".

Overall, the Circuit Court found (A18):

> "When viewed in light of the prior art, the
> lighting figure, on the contrary, appears simply
> attractive variation on a well-played theme. It
> not project the synergistic effect necessary to
> a patent for a design which is a combination
> and well-known elements. The differences in the
> lantern do not create such a new and unexpec
> sult in the appearance of the lighting fixture as a
> as to be a product of invention or of a skill b
> that of the ordinary designer in the art."

The great bulk of the Circuit Court's holding
based on documentary evidence, as to which it wa
bound by F. R. C. P. 52(a), *Deep Welding Inc. v. S
Bros., Inc.*, 417 F. 2d 1227, 1229 (7th Cir., 1969); *Dee
Bros. Inc. v. Buffalo Metal Container Corp.*, 352 F. 2
423 (2nd Cir., 1965); *Southern States Equipment Co
USCO Power Equipment Corp.*, 209 F. 2d 111, 117 (5
1953).

Kidde's expert witness, Robert Stith, was a d
of long experience (having designed custom lightin
tures before the First World War when the bulk
lighting fixtures were of custom design rather than
catalog or off the shelf items). He testified to the int

---

2. (Cont'd.)
"Almost identically to the Hadco lantern, however, the
though they appear round rather than hexagonal, curve in
as they rise, and flare out horizontally over the cages a
lower edges, terminating in a rippled design. Except for
four sided, the cages also are virtually identical to that
Hadco fixture in contour of silhouette."

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liarity of his generation of lighting fixture designers the components making up a lighting fixture of the set forth in the patent in suit, and how such designers sembled and restyled these well-known components to luce on demand a plethora of designs.[3]

The Circuit Court correctly found that it was within skill of such a lighting fixture designer to retain or de- these well-known components, or to modify their shape contour.

The Patent in Suit Being Directed to a Combination Must Meet the High Standards of Combination Patents.

The standards for combination patents have been set his Court in *Great Atlantic & Pacific Tea Co. v. Super- et Equipment Corp.*, 340 U. S. 147, 152 (1950); *Ander- -Black Rock, Inc. v. Pavement Salvage Co., Inc.*, 396 57, 61 (1969); and *United States v. Adams*, 383 U. S. 1966). These were precisely the standards which the nit Court followed, even to quoting from *A&P* and *rson's-Black Rock* (A7-8):

"Where, as in the present case, a combination patent is involved, additional aspects of nonobviousness come

3. Hadco misstates Stith's testimony in its Petition. By way ample, at page 13, it faults the Circuit Court for stating that ped rippled borders with indented triangle accents were fre- ly placed on the lower edges of roofs and vent caps as shown in tent in suit, asserting that Stith's testimony regarding the prior lated only to a sinuous curve. However, as reference to A66 s clear, Stith was testifying *precisely* as to the structure shown gure 1 of the patent in suit (A66):

"Q. Now, in connection with roofs of that period used on nterns, was it common to have the peripheral edge of the roof avy with a sinuous curve *as shown in Figure 1 of the patent suit?* (Emphasis added)

"A. It was frequently done because it was, I think, the heapest and easiest decoration that could be put therein."

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into play. The court must 'scrutinize combi
patent claims with a care proportioned to the dif
and improbability of finding invention in an ass
of old elements.'[18] Such a patent must create a
gistic effect, one in which the combination of el
results 'in an effect greater than the sum of the s
effects taken separately.'[19]"

"18. *Great Atlantic & Pacific Tea Co. v. Super
Equipment Corp.*, 340 U. S. 147, 152 (1950).

"19. *Anderson's-Black Rock, Inc. v. Pavement S
Co., Inc.*, 396 U. S. 57, 61 (1969); *United States v. A
383 U. S. 39 (1966)."

**It Is Specious to Argue That Under the Stan
Established by the Court of Appeals, No Des
Patentable.**

Hadco asserts that under the standards of the C
Court it is not possible to sustain the validity of any d
patent. This assertion is hypothetical and not a p
question for review. Moreover, the assertion is simpl
true.

Both the District and Circuit Courts applied e
tially the same standard. At no time heretofore did H
assert that the standard is too strict or improper.

What is involved in the case at bar is a design
differs from the prior art by mere trifles. Such desig
far short of the Constitutional standard.[4]

A collection of designs, many of which would me
constitutional standard, is set forth in The Design C

4. Hadco appears to seek a separate standard for design
is followed by other patents, notwithstanding that there is a
constitutional standard for all patents be they for mechanical d
designs or plants. Moreover, 35 U. S. C. 171 explicitly pr
that the patent statutes relate to design patents as well as to
patents. If this is to be changed, it should be done by constitu
amendment and legislative reform, and not by court decision,
Cullough v. Maryland, 4 Wheat. 316 (1819). Patent right
only by virtue of statute, *Wheaton v. Peters*, 8 Pet. 591, 658 (1

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of the New York Museum of Modern Art, a portion of
h is displayed in its Philip L. Goodwin Galleries of
itecture and Design.

Many of these pieces are shown in the book entitled:
e Design Collection, Selected Objects, The Museum of
ern Art, New York" published by the Museum of
ern Art in 1970. This book's preface reads in part:

"The Design Collection of The Museum of Modern Art was established in 1934 and now includes over 1,800 mass-produced or handmade objects. They have been selected on the basis of their quality and historical significance to illustrate the development of design during the past seventy-five years.

"Some 125 of these objects—including household and office appliances, tableware, tools, and furniture—are continuously exhibited in the Philip L. Goodwin Galleries, opened in 1964 and named in honor of the architect who from 1935 to 1940 was chairman of the Museum's Department of Architecture and Industrial Art. This international selection presents both an historical survey of styles, from Art Nouveau to the present, *and a standard of reference for judging contemporary design.*" (Emphasis added.)

The book illustrates such outstandingly inventive de-
s as the Charles Eames lounge chair and ottoman, Eero
rinen molded plastic armchair, Mies van der Rohe
ge chair, Frank Lloyd Wright desk, Nizzoli design for
Olivetti typewriter, and inventive designs in a folding
phone, coffee grinder, lamp, portable radio, control
el for an IBM 305, etc.[5] Many of these designs conform

5. A photograph of a portion of the Philip L. Goodwin Galleries
Architecture and Design is set forth in the accompanying Ap-
ix.

to the standard of the Constitution, and promote progress of the useful arts. In contrast, the patented sign simply constitutes a slight variation from the p art, easily within the skill of an ordinary worker in the or ordinary designer.

Hadco Would Have This Court Withdraw From Constitutional Standard and Adopt the Stan of the Patent Office.

At page 22 of its Petition, Hadco bemoans that Patent Office continues to accept design applications a issue about three thousand design patents every ye unsuspecting inventors who are led to believe that they receiving protectable rights".[6]

Hadco's apparent solution for this alleged proble to have this Court abandon the Constitutional standard adopt that of the Patent Office.

Manifestly, the subject situation is a clear case of this Court has termed "the notorious difference bet the standards applied by the Patent Office and by courts", i.e. *Graham v. John Deere Co.*, 383 U. S. 1, 1 (1966):

> "We have observed a notorious difference betwee standards applied by the Patent Office and by courts.
>
> * * *
>
> "Although we conclude here that the inquiry w the Patent Office and the courts must make as to pa

6. As set forth in the book *The Design Collection*, quoted f the Museum of Modern Art has selected 1,800 designs as m the "standard of reference for . . . design" for the past seven years. This 1,800 designs in seventy-five years contrasts wi Patent Office issuing "about three thousand design patents year."

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ility must be beamed with greater intensity on the quirements of § 103, it bears repeating that we find change in the general strictness with which the over- test is to be applied. We have been urged to find in 103 a relaxed standard, supposedly a congressional action to the 'increased standard' applied by this ourt in its decisions over the last 20 or 30 years. The andard has remained invariable in this Court."

he Presence of Secondary Factors, Such as Commercial Success, Will Not Make for Patentability Without Invention.

he District Court was overly impressed by the alcommercial success of the design of the patent in suit. ver, secondary factors, such as commercial success, lfillment of long-felt need, cannot make up for the e of invention. The Circuit Court gave measured t[7] to all of these secondary considerations, and deed that invention was plainly lacking (A20):

Under the mandate of *John Deere, supra,* this court as given measured weight to secondary considerations such as commercial success, the opinion of other anufacturers in the pertinent art, and the fulfillment f long-felt need.[50] In determining the validity of a esign patent, however, the primary target of inquiry emains the design itself, and the presence of secndary factors 'without invention will not make

"50. *Philips Electronic and Pharmaceutical Industries orp. v. Thermal and Electronic Industries, Inc.,* 450 F. 2d 164, 1174 (3 Cir. 1971); *Frank W. Egan & Company v. Modern Plastic Machinery Corp.,* 387 F. 2d 319, 324 (3 Cir., 967) *cert. den.* 361 U. S. 883 (1959).

Hadco's statement at page 7 of its Petition that the Circuit rejected these secondary considerations as "altogether irrele- is a gross misstatement of the record.

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patentability.'[51] Having concluded that the d
itself is not a product of invention, it cannot be
tained as nonobvious on the basis of other seco
considerations. 'Where . . . invention is p
lacking, commercial success cannot fill the void

"51. *Anderson's-Black Rock, Inc. v. Pavement S
Co., Inc.*, 396 U. S. 57, 61 (1969); *E. J. Brooks Com
Stoffel Seals Corp.*, 266 F. 2d 841, 844 (2 Cir., 1959).

"52. *Jungersen v. Ostby & Barton Co.*, 335 U. S
567 (1949)."

CONCLUSION

The petition should be denied.

Respectfully submitted,

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Appendix

THE PATENTEE DAUM DEFINED THE ESSE HIS DESIGN AS:

> **"PRIMARILY, SILHOUETTE. THAT IS MAKES IT INTERESTING TO THE EYE."**

SEE PAGES 3 AND 4, SUPRA.

Figure 1 of Daum Patent Application Drawing, DX-191, imposed Over Prior Art Herwig Fixture, DX-220, Ref in Opinion of Circuit Court as "Kidde's Item No. 5, M See Footnote 35 to Opinion of Circuit Court at A1 Principal Differences in Contour Between the Two I Are Due to Errors in the Drawings of the Daum Paten cation, Namely the Outside Simulated Ventilators, Whic Conceded Should Not Be on the Drawings, See Footn Circuit Court's Opinion at A3.

Photograph Showing Portion of Designs on Display a
Philip L. Goodwin Galleries of the New York Mus
Modern Art, Which Meet a High Standard, See Page 7
Among the Designs Shown in the Photograph Are: Pu
Helmet, Pail, Pots, Ice Cream Scoop, Telephone, Chair,
and Table.

(15)